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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,395	07/11/2003	Ian W. Cunningham	5658/937	5505
24239	7590	08/08/2006	EXAMINER	
MOORE & VAN ALLEN PLLC P.O. BOX 13706 Research Triangle Park, NC 27709			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,395

Applicant(s)

CUNNINGHAM ET AL.

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-38, 44, 45 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) 19-32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 11-18, 44, 45 and 47-51 is/are allowed.
- 6) ☒ Claim(s) 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 19-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Weisburn (Patent no. 5,550,953). A product storage and display container is disclosed comprising a container 2 defining a compartment adapted to hold a plurality of tool bits in as much as is claimed, and a hanging tag 3 rotatably¹ attached to the container. An aperture 31 is dimensioned for receiving a display hook A. As shown in figure 3 the hanging tag is removable from the container.

As to claim 38, the container further comprises a flip-top lid 5.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹ To turn around on an axis or center, dictionary.com (rotatable).

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (Patent no. 5,137,209). Roberts discloses a container which soap or detergent powder is packaged. The difference between the claimed subject matter and Roberts resides in a plurality of products housed in the container (claim 33) and the products being a plurality of tool bits.

Official Notice is notoriously old and well known to use household packages to hold other contents once the original product has been consumed or used. Boxes, pails or other containers are often used around the house to hold other contents. It would have been obvious to one skilled in the art at the time the invention was made to employ the container of Roberts to hold a plurality of products such as tool bits in view of Official Notice, in order to provide a secondary utility to the package, obviating the need to buy additional storage containers.

As to the tag having labeling information thereon, the employment of indicia relates to printed matter that fails to distinguish the labeling tag on this basis alone.

In order for such "printed matter" to distinguish the invention from prior art, in terms of patentability, the printed matter must be functionally related to the substrate in order to be entitled patentable weight.ⁱ In the present case the labeling information does not make the display tag "movable" between a first and second position, nor does the labeling information depend upon the package and the package does not depend upon the printed matter. Since the prior art meets all of the structural and functional limitations previously recited, adding the labeling information to the claim merely teaches a different use of an existing product. Accordingly, the printed matter is of no patentable distinction.ⁱⁱ

Allowable Subject Matter

7. Claims 1-8, 11-18, 44, 45 and 47-51 are allowed.

Response to Arguments

8. Applicant's arguments filed May 22, 2006 have been fully considered but they are not persuasive.

As to claim 33 applicant contends Roberts cannot be interpreted to meet the tag limitation of claim 33. Apparently due to the fact that a handle is not structurally or functionally equivalent a tag. However, this is not agreed. At least in the context of the present disclosure. The tag of applicants' invention must be capable of supporting the containers weight in order to function. The hole or aperture in the tag also functions as a opening for container support. Hence, the present invention display "tag" is both structurally and functionally akin a handle as demonstrated herein. Also, it should be noted claims are to be given their broadest reasonable during prosecution, see *In re Priest*, 582 F.2d 33, 37 199 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997), see MPEP 2106. Accordingly, it is maintained Roberts discloses "tag" in as much as is claimed and disclosed.

As to the addition of the labeling information, it is not seen how the addition of printed matter would serve to patentably distinguish the claimed subject matter over the prior art. Applicant argues that "Claim 33 requires a display tag having labeling information located thereon rotatably mounted to the container". However, as noted above, the labeling information is not rotatably mounted nor does the indicia impart some structural characteristic to the device. The handle of Roberts is rotatably mounted and manifestly movable from a lifting position to one where the is off to the side or "behind" the container. Much like any bucket or pail would have a handle rotated off to the side. The addition of "labeling information" does nothing to distinguish the claim over the prior art on that basis. Accordingly, the rejection has been maintained.

As to claim 37, applicant argues the hanger 3 of Weisburn is not rotatable relative to the box, such that claim 37 defines over Weisburn. However, that is precisely what Weisburn shows in figure 1. A removable tag that is rotated relative to the container.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

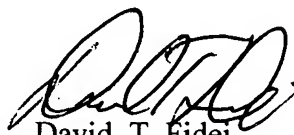
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei
Primary Examiner
Art Unit 3728

dtf

August 6, 2006

ⁱ In re Gulack, 217 USPQ 410 (CAFC 1983)

ⁱⁱ In re John Ngai and David Lin (CAFC, 5/13/2004), NONPRECEDENTIAL OPINION ISSUED March 8, 2004, PRECEDENTIAL OPINION ISSUED May 13, 2004.